

In the Office Action dated June 4, 2007, the Examiner renewed the prior rejections of all pending claims. For the reasons discussed below, the Applicant traverses these rejections and requests reconsideration thereof.

The pending claims are directed to a composition of matter, not a method of making the composition of matter. Specifically, the pending claims are directed to a fiberboard composition. The fiberboard composition comprises at least three layers of material. Two layers are static dissipative linerboard. Positioned between the layers of linerboard is a layer of paperboard. The terms fiberboard, linerboard and paperboard are defined in the specification (paragraphs 15, 16 and 20). Based on the definitions provided therein, it is clear that the terms linerboard and paperboard describe material having a degree of thickness.

Referring to Claim 9, each layer of material forming the fiberboard composition includes a substance which is substantially homogeneously dispersed throughout the material. By definition, when a substance is dispersed throughout another material, the dispersed substance is *within* the material. A substance added as a coating is not homogeneously dispersed *throughout* the material. Thus, when properly interpreted the claim places the dispersed material within not on each layer. This interpretation is consistent with the guidance provided by the MPEP §2111, which advises that “[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), emphasis added.

Accordingly, the Applicant respectfully disagrees with the Examiner’s contention that “additives homogeneously dispersed on the surface of the substrate, i.e., as coats, the reference still reads on the claims as claimed.” (emphasis added) Dispersing a compound on the surface of a substrate is not the equivalent of dispersing the same substance throughout the substrate. The

former is a coating which may wear off; whereas, the later effectively changes the composition of the substrate. In the current invention, as the substrate wears, additional dispersed material is exposed thereby maintaining the desired characteristics without the need to apply a new coating.

This interpretation of the claims does not require reading subject matter from the specification into the claims. Rather, it merely requires imparting the common everyday meaning to the claim elements. Further, the definitions provided in the specification are to be applied to the claim terms. Linerboard and a paperboard have sufficient thicknesses to permit incorporation of a homogeneously dispersed additive. The claim element, “homogeneously dispersed throughout the paperboard” refers to that particular component of the fiberboard composition. Thus, the electrically conductive substance is found within, not on, the paperboard portion of the composition. Similarly, the claim element referring to the linerboard component of the fiberboard composition clearly describes the static dissipative substance as being found within the linerboard. Thus, the pending claims do not require the use of a “coating” on either the linerboard or paperboard components of the fiberboard composition.

Using a food analogy, cherry gelatin may have fruit dispersed throughout the gelatin or a layer of whipped topping on its surface. Clearly, the dispersion throughout differs from the layer on top. The prior art references relied upon for the anticipation rejection of the claims do not teach or suggest a fiberboard composition wherein static dissipative material is substantially homogeneously dispersed throughout the linerboard component and electrically conductive material is substantially homogeneously dispersed throughout the paperboard component.

Concerning the §103 rejection of the claims on the basis of the §102 references combined with Yasuda, the Applicants respectfully traverse this rejection and request reconsideration thereof. The Yasuda disclosure provides for the combination of a surface active agent having an HLB of less than 9 with an inorganic powder. The HLB must be low in this instance to preclude loss thereof to the water used in the paper manufacturing process. HLB is a ratio of the lipophilic to hydrophilic portions of a surfactant or emulsifier. In Yasuda, the specific surfactants are provided in col. 2. Since these compounds have an HLB of less than 9, they are insoluble in water or only slightly soluble in water.

The Applicants note that none of the compounds described in Claim 13 are found in col. 2 of Yasuda. Rather, the compounds disclosed by Yasuda are at best potential derivatives of the compounds used in the present invention. Further, these compounds have low solubility in water. In contrast, the claim 13 compound, poly(diallyldimethylammonium chloride), polyethylene glycol, are clearly soluble in water and the diethanol amide is likely soluble in water in view of the polar hydroxyl groups. The Applicant submits that the compounds in Yasuda do not teach or suggest the compounds described by Claims 13 -16 and 50. Further, the disclosure of Yasuda would not motivate one skilled in the art to use the compounds of the present invention in materials disclosed by the §102 references. Therefore, the combination of Yasuda with the §102 references does not establish a prima facie basis for a §103 rejection of the pending claims.

In view of the foregoing arguments, the Applicant respectfully requests reconsideration and withdrawal of the rejections of the pending claims. A formal Notice of Allowance of claims 9-21 and 49-51 is earnestly solicited. If the foregoing discussion of the claims is insufficient to overcome the Examiner's §102 and §103 rejections based on the prior art, the Applicant

respectfully requests a telephone call from the Examiner to further discuss the issue of a "dispersion throughout" versus a coating "dispersed on" the paperboard and linerboard. The Applicant submits such a call will advance the prosecution of the application thereby obviating the need to file an RCE.

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Respectfully submitted,



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